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09/920,236	07/31/2001	Norman Yamamoto	2983-US	5853
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EXAMINER				
NORDMEYER, PATRICIA L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/920,236

Applicant(s)

YAMAMOTO, NORMAN

Examiner

Patricia L. Nordmeyer

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-12, 14, 15, 17, 20-26 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-12, 14, 15, 17, 20-26 and 29-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102(b) rejection of claims 9 – 12 and 17 as anticipated by Coopridier et al. (USPN 5,972,155) in the office action dated August 9, 2007 is withdrawn due to Applicant's amendments in the response dated December 10, 2007.
2. The 35 U.S.C. 103(a) rejection of claims 15, 25 and 26 over Coopridier et al. (USPN 5,972,155) in the office action dated August 9, 2007 is withdrawn due to Applicant's amendments in the response dated December 10, 2007.

Repeated Rejections

3. The 35 U.S.C. 103(a) rejection of claims 1, 2, 4 – 8, 14, 20 – 24 and 29 – 34 over Coopridier et al. (USPN 5,972,155) in view of Boudet (USPN 3,950,580) in the office action dated August 9, 2007 is repeated as Applicant's arguments in the response dated December 10, 2007 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

Coopridier, as discussed above, fails to teach the presence of a plurality of liners positioned over the at least one strip of adhesive material and adjacent to one a first one of the plurality of side edges with one of the plurality of liners located between the first one of the plurality of side edges and another one of the plurality of liners. Boudet discloses sheet with a plurality of liners (4, 5) positioned over the at least one strip of adhesive material and adjacent to one a first one of the plurality of side edges with one of the plurality of liners located between

the first one of the plurality of side edges and another one of the plurality of liner (as shown in the drawings). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Boudet's teaching of using a plurality of liners, as claimed in the invention of Cooprider with the motivation to provide for selectively adjusting the adhesiveness.

For claim 2, Cooprider discloses that the sheet is opaque paper.

For claim 4, the adhesive in Cooprider is pressure sensitive adhesive.

As for claim 5, see Cooprider, col. 5, line 17-20, wherein it is stated that the adhesive along edge 21, extends from one side edge to the other only partially because the adhesive (4) along a side edge (24) is shown to extend to the end.

For claim 6, Boudet teaches, in col. 1, lines 47-50, a plurality of adhesive strips and plurality of liners there over.

For claim 7, Cooprider, in figure-1, shows that the adhesive strip defines a width that is less than the width of the opaque sheet.

As for claim 8, the adhesive extends substantially from one longitudinal end of one of the plurality of side edges to the other longitudinal end of the one of the plurality of side edges (col. 5, line 47-50).

For claim 14, it would have been obvious matter of design choice to modify Boudet by providing plurality of adhesive strips adjacent a second side edge, with respective release liners, based on duplication of parts.

For claim 20, adhesive strip with plurality of release liner would have been obvious matter of design choice modification of Cooprider in view of Boudet, as explained hereinabove.

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As for claims 21-22 dependent from claim 7, said claims have been explained hereinabove for claims 1-2.

For claims 23-24, dependent from claim 14, said claims have been explained hereinabove for claims 1-2.

For claim 29, the sheet size is disclosed in Cooprider, as explained hereinabove.

For claim 30, Boudet teaches that the plurality of release liners is spaced.

Regarding claim 31, the plurality of spaced liners is parallel to one another.

As for claims 32 and 33, the sheet of Boudet can be rotated by 90 degrees to provide said plurality of spaced release liners vertically spaced and parallel to one another.

Regarding claim 34, the sheet of Cooprider is a printable sheet and can have print thereon (col. 7, lines 35-37).

With respect to the use of a particular printer, it is directed to an intended use of an apparatus which is not deemed to be of positive limitation for a product claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9 – 12, 15, 17, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooprider et al. (USPN 5,972,155) in view of Chen et al. (USPN 4,898,323).

Cooprider relates to a printable media (figure-1) comprising an at least substantially opaque sheet (20 and col. 4, lines 46-47) defining a front side, a rear side and at least first and second intersecting side edges (*figure-3 shows a first side, a second side, and figure-1 shows the sheet having first and second intersecting side edges*), each of said first and second edges defining opposing longitudinal ends (*figure-1 shows the side edges to have opposing longitudinal ends*), one of longitudinal ends of each of the first and second longitudinal side edges defining a common longitudinal end (as shown in figure-1); a substantially continuous first strip of adhesive (40) material on one of the front and rear sides of the at least substantially opaque sheet adjacent to the first side edge (24) and extending substantially from one longitudinal end of the first side edge to the other longitudinal end of the first side edge; and a substantially continuous second strip of adhesive material (col. 5, lines 17-20) on one of the front and rear sides of the at least substantially opaque sheet adjacent to the second side edge (21) and extending substantially from one longitudinal end of the second side edge to the other longitudinal end of the second side edge. For claims 10 and 26, the opaque sheet comprises paper sheet (col. 4, lin 48). For claims 11 and 26, the opaque sheet is 200 to 1000 sqcm (col. 4, lines 35-42), which includes the claimed size. As for claim 12, the adhesive material comprises pressure sensitive adhesive (col. 6, line 8). For claim 17, the above explanation for claim 9 provides for the printable media of claim 17. Additionally, Cooprider also teaches that first and second liners (50, 50) respectively covering the first and second strips of adhesive material (40, 40); and that a liner corner member (*the portion of the liner 50 at the common longitudinal end is interpreted to be the liner corner member*) adjacent to the common longitudinal end of the first and second side edges. Cooprider, as discussed above, and as shown in figure-1, has a common longitudinal end (intersecting side

edges 24 and 21) with respective release liner. However, Cooprider fails to teach that the liners have mitered ends adjacent to the common end and that the adhesive is a permanent adhesive. It would have been obvious to one having ordinary skill in the art to modify Cooprider by providing mitered ends shape to the liners for aesthetic appeal and/or facilitating the removability thereof. A change of shape is found to be within the level of one of ordinary skill in the art.

Chen et al. teach that the adhesive is a permanent adhesive (Column 5, lines 25 – 26) that is covered by a release liner (Column 5, lines 26 – 29) as part of a printable media (Column 2, lines 9 – 10) of a standard or larger size paper (Column 1, lines 35 – 38) for the purpose of changing the formation of the printed media (Column 1, lines 50 – 52).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the permanent adhesive in Cooprider et al. in order to change the formation of the printed media as taught by Chen et al.

6. Claims 35 – 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooprider et al. (USPN 5,972,155) in view of Boudet (USPN 3,950,580) as applied to claims 1, 2, 4 – 8, 14, 20 – 24 and 29 – 34 above, and further in view of Chen et al. (USPN 4,898,323).

Cooprider et al., as modified with Boudet, disclose the claimed printable media except for the adhesive being a permanent adhesive.

Chen et al. teach that the adhesive is a permanent adhesive (Column 5, lines 25 – 26) that is covered by a release liner (Column 5, lines 26 – 29) as part of a printable media (Column 2, lines 9 – 10) of a standard or larger size paper (Column 1, lines 35 – 38) for the purpose of changing the formation of the printed media (Column 1, lines 50 – 52).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the permanent adhesive in the modified Coopridner et al. in order to change the formation of the printed media as taught by Chen et al.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 4 – 12, 14, 15, 17, 20 – 26 and 29 - 37 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's arguments that Coopridner et al. fail to disclose a permanent adhesive, please see the new rejection in view of Chen et al.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, Coopridet et al. and Boudet are obvious to combine due to the fact that they are both directed towards the use of adhesive with release liners.

In response to Applicant's argument that the prior art fails to teach a plurality of release liners, Boudet discloses sheet with a plurality of liners (4, 5) positioned over the at least one strip of adhesive material and adjacent to one a first one of the plurality of side edges with one of the plurality of liners located between the first one of the plurality of side edges and another one of the plurality of liner (as shown in the drawings). Therefore, it is known to use multiple release liners on one adhesive location.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

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Primary Examiner, Art Unit 1794